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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/756,523	01/13/2004	Paul Giegerich	9249-50U1	2335

570 7590 03/03/2006

AKIN GUMP STRAUSS HAUER & FELD L.L.P.
ONE COMMERCE SQUARE
2005 MARKET STREET, SUITE 2200
PHILADELPHIA, PA 19103

EXAMINER

PASSANITI, SEBASTIANO

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 03/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/756,523	GIEGERICH, PAUL	
	Examiner	Art Unit	
	Sebastiano Passaniti	3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12/05/2005 (Amendment).
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10 is/are rejected.
- 7) ☒ Claim(s) 11 and 12 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Office action is responsive to communication received 12/05/2005 –
Amendment.

Claims 10-12 remain pending.

Following is an action on the MERITS:

Applicant's attention is drawn to the newly supplied rejection of claim 10 based upon Traficante in view of Lyons. In addition, the rejection of claim 10 under §102 based upon Lyons is maintained. The rejection of claim 12 has been overcome, as discussed herein below.

Claim Rejections - 35 USC § 102 and 103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The claims are being examined on the basis that the claims are a combination requiring the presence of a visual barrier and a game table.

Claim 10 STANDS rejected under 35 U.S.C. 102(b) as being anticipated by Lyons. Note visual barrier (16) releasably attachable to at least one support arm (52, 54).

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Traficante in view of Lyons. The patent to Traficante shows a visual barrier (13) constructed from an opaque material such as cardboard, wood or opaque plastic. Traficante differs from the claimed invention in that Traficante does not show a support coupled to the game table. Instead, Traficante shows slots (40, 40') into which the barrier may be inserted. Note, Traficante does state that a number of common means may be used to hold the barrier in place (col. 6, lines 5-18). Lyons shows it to be old in the art to support and contain a visual barrier using at least one support arm. In view of the patent to Lyons, it would have been obvious to modify the device in the cited art reference to Traficante by using a support arm structure in place of the slots (40, 40'), the motivation being to take advantage of another common means for holding the barrier (13) in an upright position on the game board.

Allowable Subject Matter

Claim 11 STANDS and claim 12 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Further Prior Art of Interest

Schmanski shows a visual barrier and a support system for the same.

Response to Arguments

In the arguments received 12/05/2005, the applicant contends that the prior art reference to Lyons shows a transparent shield (16) to block the ball (56) from striking players in the event that the ball travels off the playing surface and therefor does not anticipate the claimed "visual barrier" that is designed to obscure a user's view of at least a portion of the playing field. The applicant further contends that one of ordinary skill in the art would not have replaced the transparent shield of the Lyons device with the field hurdle of the Schwartz device because the hurdle is not sized not shaped to block balls that are directed off of the playing surface. Moreover, the applicant contends that the skilled artisan would not have been motivated to employ the height adjustability used by Schwartz to modify the attachment of the Lyons device to the game table because the height in Lyons is designed to be fixed such that a ball that leaves the playing surface is blocked or deflected from hitting an opposing player when the ball leaves the playing surface.

In response to these arguments, it is noted that the claimed "visual barrier", as broadly as claimed, is anticipated by Lyons. Although the applicant argues that the Lyons device includes a transparent shield and that the invention includes an opaque material for the barrier, this limitation of an opaque material is not found in the claims. Claimed subject matter, not the specification, is the measure of invention. Limitations in the specification cannot be read into the claims for the purpose of avoiding the prior art. See *In re Self*, 213 USPQ 1, 5 (CCPA 1982); *In re Priest*, 199 USPQ 11, 15 (CCPA 1978).

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Applicant's arguments with respect to the combination of Lyons and Schwartz, as outlined on page 3, line 25 through page 5, line 7 of the remarks received 12/05/2005, have been deemed persuasive. Thus, the rejection of claim 12 based upon Lyons in view of Schwartz has been overcome.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sebastiano Passaniti whose telephone number is 571-272-4413. The examiner can normally be reached on Monday through Friday (6:30AM - 3:00PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eugene L. Kim can be reached on 571-272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

S.Passaniti/sp
February 27, 2006


Sebastiano Passaniti
Primary Examiner